

(c) REMARKS

The claims are 1-26 with claims 1, 21, 22 and 25 being independent. The independent claims have been amended to more specifically define the intended invention. The dependent claims have been amended in order to conform to the new preamble. Reconsideration of the claims is expressly requested.

The Examiner has rejected claims 1-26 as obvious over Onuma '778 in view of Matsunaga '490 and Matsunaga '234. Claims 1-22 were provisionally rejected as a non-statutory double patenting over claim 1 of allowed Application No. 10/212,150. The grounds of rejection are respectfully traversed.

Initially, support for the amendment to the independent claims concerning the amount of coloring agent is found, inter alia, on page 38, lines 24-26.

The present claims have been amended to provide that the toner is non-magnetic. That is, the toner does not contain magnetic materials as a unitary constituent of a one-component toner. Support for the amendment is found, inter alia, on page 94, lines 15-22. At that portion of the specification it is disclosed that a cyan toner is formed as a one-component toner. In order to form a two-component magnetic developer, magnetic ferrite carrier particles are mixed with the cyan toner.

Further, support for a non-magnetic toner is found on page 34, lines 18-22. It is disclosed therein that the (non-magnetic) toner can contain a magnetic material and, once the magnetic material is added, the toner is then used as a one-component magnetic toner. See page 35, lines 10-12. When magnetic material is added, it is melt-kneaded or the like (page 41, lines 6-10) to form a one-component toner.

Further, as noted on specification page 35, lines 18-25, it is disclosed when the toner is used as a one-component toner carried on a separate magnetic developer carrier, it is preferable that only 0.1 to 4 parts of magnetic material are present per 100 parts binder. Accordingly, the amount of magnetic material present in the one-component toner is only about from 0.1 to 4% by mass. The magnetic carrier is then admixed to form a two-component magnetic developer.

The toner employed in present Examples 1-12 of the present invention is a non-magnetic toner. Each toner has the deformation properties as presently claimed. More specifically, in present Example 1 (as well as Examples 2-11), it is disclosed that the non-magnetic toner of the present invention is mixed with a magnetic carrier to obtain a two-component-based developer and, thereafter, the resultant two-component-based developer is used to develop an image by a copying machine. In present Example 12, it is disclosed that the non-magnetic toner of the present invention which is not mixed with a magnetic carrier is used for non-magnetic one-component development by a printer. As shown in Tables 4 and 5, fixability is enhanced, offset is reduced and the resulting images had good transparency and superior color mixing properties.

Accordingly, although Applicants have disclosed that the toner can optionally be a magnetic toner, nonetheless, the present claims recite that the toner is a non-magnetic toner. Accordingly, these are insufficient magnetic materials present, if any, in the present non-magnetic toner to make the toner useable as a one-component magnetic toner. Applicants have found that to provide enhanced results, a non-magnetic toner should be employed having a specific deformation amount under specific load. As noted

on page 8, the deformation amount represents a compressed ratio of the sample at specific load when a compressing force is applied to the sample being heated. The deformation amount is correlated with a fixing property of the toner and with the surface property of the fixed image, as well as the permeability at the time of fixing of the image onto an OHP sheet.

Applicants understand that typical magnetic materials added to form one-component magnetic toners can be relatively hard and are not easily deformed. Accordingly, toners which contain magnetic materials in amounts on the order of 50% by wt. or greater, can barely be deformed and, accordingly, the deformation range of such toners is not within the range of the present claimed invention. In other words, with typical magnetic toners there is insufficient deformation required as a minimum in the present claimed invention.

With regard to the art rejection, it should be understood that each of the cited references, Onuma '778, Matsunaga '490 and Matsunaga '234 are silent with regard to deformation amount of a toner. The Examiner has argued that the amount of deformation of a toner is related to a binder resin. The Examiner argues Matsunaga '490 uses the same binder resin as Applicants and therefore, can be expected to have similar rheological characteristics when used as a binder in a composition of Onuma to enhance fixability. Applicants will demonstrate that this argument is incorrect.

Each of the working examples of Onuma '778, Matsunaga '490 and Matsunaga '234 is directed to a one-component magnetic toner, not a non-magnetic toner. In each Example 1 of the cited references, the magnetic material is present in amounts from

about 80 to 90 parts and the binder resin is present in amounts from 100 to 104.5 parts. Accordingly, the magnetic material is present in a weight ratio of about 50% based on the toner particle.

As noted above, when the magnetic material is present in amounts on the order of 50% or more based on the toner particle, the particle can barely be deformed. Accordingly, the value of the deformation amount of such prior art toners is less than the lower deformation limit value of the present invention. Satoshi Matsunaga named as an inventor in each of the cited references is the same Satoshi Matsunaga of the present claimed invention. Accordingly, Applicants are well aware of the disclosure of the cited references and of the failure of the Examples of the cited references to achieve the value of the instant claimed deformation values.

Further, there is no motivation to alter the prior art toners to achieve the present claimed deformation ranges, since the problems addressed by the present invention are not specifically appreciated in the references nor are solutions to those problems discussed in the references. Specifically, none of the references discloses the advantages of providing the claimed deformation amounts in order to enhance fixability. To the contrary, the illustrative Examples in each of the cited references uses a magnetic toner containing on the order of 50% by weight magnetic materials which would teach away from the present claimed invention employing a non-magnetic toner with different deformation values.

With regard to Schneller-type the non-statutory double patenting rejection based on claim 1 of Application No. 10/212,150, the Examiner has argued that the subject

matter claimed in the instant application is fully disclosed (emphasis supplied) in that copending application and would be covered by any patent granted on the copending application. The Examiner also argues there is no apparent reason (emphasis added) why Applicant was prevented from presenting claims corresponding to those in the present application in the copending application. The grounds of rejection are respectfully traversed.

Firstly, the MPEP specifically warns that non-statutory double patenting rejections based on Schneller will be rare. See MPEP §804 II.B.2. In order for Schneller to apply the courts have required that the claimed invention must be fully disclosed and covered by the claims of the issued patent. Next, once it has been established that the instant invention is fully disclosed and covered by the claims in the patent, it must be found that patent protection would be extended by allowance of the patented claims.

It will be demonstrated that the present claimed invention is not fully disclosed and nor is covered by the claims of pending Application No. 10/212,150. Secondly, it will be demonstrated that patent protection in Application No. 10/212,150 (the copending application) would not be extended by the allowance of the present claims.

Initially, the copending application does not disclose a non-magnetic toner which satisfies the deformation amounts of the toner provided by the present claimed invention. There is simply no disclosure in the copending application regarding deformation amounts of non-magnetic toners nor how providing specific deformation amounts alleviates problems with fixability. Accordingly, not only is the present invention

not “fully” disclosed in the copending application, it is not found at all within the disclosure therein.

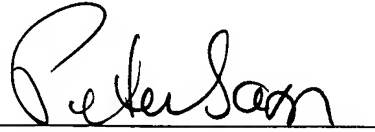
Secondly, the claims of the copending application are not directed to a non-magnetic toner, nor do they recite a coloring agent present in amounts from 1 to 15 parts by mass based on 100 parts by mass of binder resin. Further, the copending claims do not recite any deformation amounts within the instant ranges. More specifically, the claims of the copending application cover a magnetic toner. Specifically, in Example 1 of the copending application, a one-component magnetic toner containing on the order of 50% magnetic material is disclosed.

Accordingly, Schneller does not apply because the present invention is not fully disclosed and nor is “covered” by the claims of the copending application. There is a strong reason why claims corresponding to those of the present application could not be presented during prosecution of the copending application. That is because the copending application lacks support for the instant claimed invention. Lacking such support, it is clear that the Schneller case cannot apply and the non-statutory double patenting rejection should be withdrawn.

Wherefore, it is respectfully requested that the claims be allowed and that the case be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

Peter Saxon
Attorney for Applicants
Registration No. 24,947

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
NY_531990v1